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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Mary Ann Copas, Secretary

In the Application of Ernst Michael Winter, et al

Ser.No.: 09/319,142

Filed: May 28, 1999 (U.S. National Stage)
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CPA Filed: April 23, 2001

For: GEMSTONE

Art Unit: 1772

Examiner: Alicia Ann Chevalier

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Assistant Commissioner for Patents

Washington, DC 20231

APPELLANTS' RESPONSE TO EXAMINER'S ANSWER

Dear Sir:

In response to the Examiner's Answer dated January 15, 2003, the Appellants hereby submit their response.

In the Examiner's Answer, the following grounds of rejection of appealed claims 16-31 were maintained:

1) The rejection of claims 16-18, 20, 22-27 and 29-31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,786 to Nassau et al in view of U.S. Patent No. 2,521,846 to Gregory;

2) The rejection of claims 19, 21, and 28 under 35 U.S.C. 103(a) as being unpatentable over Nassau et al in view of Gregory, as applied to claims 16-18, 20, 22-27, and 29-31, above, and further in view of U.S. Patent No. 5,431,028 to Lampert et al.

While the Appellants disagree with the Examiner's conclusion that the appealed claims are obvious over the cited reference combinations, the Appellants propose to amend claim 16 to more clearly define the patentable distinctions of the present invention. The Appellants propose to amend claim 16 to define the "large surface-area, plate-shaped support". Amended claim 16 defines further that a thin vapor phase deposit layer, comprising a thin, surface-shaped precious synthetic gemstone layer, is applied on the large surface-area, plate-shaped support.

If the practitioner were to combine the Nassau and Gregory patents as proposed by the Examiner, he would not be led to the present invention, as defined in main claim 16. As the Examiner admits, Nassau fails to show the use of a large surface-area, plate-shaped support having a surface with a plurality of pyramid-shaped depressions. Furthermore, Nassau fails to disclose an extremely thin vapor phase deposit layer comprising a thin, surface-shaped precious synthetic gemstone layer applied on said large surface-area, plate-shaped support in a selected orientation, as defined in the proposed amendment to claim 16.

Rather, Nassau et al specifically discloses a gemstone made from silicon carbide of 0.25 to 5 carats (the size and weight of a natural diamond), which are cut

out of a synthetic silicon carbide crystal and subsequently polished like a gemstone. Then, in the traditional manner, the gemstone is placed on a piece of jewelry, for example in a setting of a ring. Since the upper or face surfaces of these gemstones can be damaged during retention in a piece of jewelry, a synthetic diamond layer is added as a protective layer

The Examiner maintains that Gregory is cited in combination with Nassau to show the plate-shaped support. However, the support disclosed in Gregory is not comparable to the large surface-area, plate-shaped support of the present invention. The Examiner states on page 4, third full paragraph, that the “flat metal vessels [of Gregory]...may have pyramid-shaped recesses...” (Emphasis added). The Appellants disagree with this speculative conclusion. Claim 16 of the present application specifically defines that the plate-shaped support has a surface with a plurality of pyramid-shaped depressions, each of said pyramid-shaped depressions having a pyramid angle formed between adjoining faces of at least one pyramid-shaped depression. Neither the disclosure nor figures in the Gregory patent disclose, suggest, or show these pyramid shaped depressions with a pyramid angle formed between the adjoining faces of the depressions provide specifically to impart decorative light qualities.

Therefore, if the practitioner did combine the plate-shaped support with the gemstone of Nassau, the result would not be a very thin, vapor deposited layer of a surface-shaped synthetic gemstone on a large surface-area, plate-shaped support with a plurality of pyramid depressions. Rather, combining these two references would only provide the practitioner with a gemstone cut from silicon carbide crystal, polished like a gemstone, and coated with a protective diamond layer on a small

support without decorative, light-imparting, pyramid-shaped depressions with pyramid angles therebetween.

As for the maintained rejection of claims 19, 21, and 28 as obvious over the combination of Nassau and Gregory and Lampert, the Appellants reiterate the arguments stated above. If the "precious metal" support of Lampert were added to the combination of the Nassau and Gregory patents, the practitioner still would only achieve a cut silicon carbide gemstone, mounted on a small support made of precious metal, not the surface-shaped, extremely thin vapor-deposited gemstone on a large surface-area, plate-shaped support with a multitude of pyramid shaped depressions for imparting decorative qualities.

Therefore, the Appellants respectfully submit that the present invention, as more clearly defined in the proposed amendment to claim 16, is indeed patentably non-obvious over the cited reference combinations for the reasons set forth above. The Appellants respectfully request entry of the proposed amendment to claim 16.

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of claims 16-31 over the cited art and hold that Appellants' claims 16-31 are allowable over such art.

Respectfully Submitted,



Robert W. Becker, Reg. No. 26,255
for applicants

ROBERT W. BECKER & ASSOCIATES
707 Highway 66 East, Suite B
Tijeras, NM 87059

Telephone: (505) 286-3511
Facsimile: (505) 286-3524